

## **REMARKS/ARGUMENTS**

Amendments were made to page 1 of the specification to update information regarding related applications identified therein. No new matter has been added by any of the amendments to the specification.

Claims 1-6, 12-17, 21-26 and 30-32 are pending in the present application. Claims 1-2, 12-13, 21-22 and 25 were amended; claims 7-11, 18-20 and 27-29 were canceled; and claims 30-32 were added. Applicants have carefully considered the cited art and the Examiner's comments and believe the claims currently in the case patentably distinguish over the cited art and are allowable in their present form. Reconsideration of the rejection is, accordingly, respectfully requested in view of the above amendments and the following comments.

### **I. 35 U.S.C. § 101: Claims 1, 10, 12, and 21**

The Examiner has rejected claims 1, 10, 12, and 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

In rejecting the claims, the Examiner states:

Claims 1, 10, 12, and 21 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claims recite processing the bill does not satisfy the requirement of 35 U.S.C. 101. Without any kind of useful output from the processing, the claimed method has no practical application or utility. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

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In order to expedite prosecution, claim 10 has been canceled and claims 1, 12 and 21 have been amended to recite that the invention is directed to processing a bill payment, and, in addition, to require that "a payment of the bill" be processed using payment information. Processing a payment of a bill is a "useful, concrete and tangible" result and provides a practical application for the invention. Claims 1, 12 and 21, accordingly, recite statutory subject matter and fully satisfy the requirements of 35 U.S.C. § 101.

Therefore, the rejection of claims 1, 10, 12, and 21 under 35 U.S.C. § 101 has been overcome.

**II. 35 U.S.C. § 102, Anticipation: Claims 1, 3, 5, 6, 10, 12, 14, 16, 17, 21, 23, 25, and 26**

The Examiner has rejected claims 1, 3, 5, 6, 10, 12, 14, 16, 17, 21, 23, 25, and 26 under 35 U.S.C. § 102(e) as being anticipated by Powar, U.S. Patent No. 6,438,527. This rejection is respectfully traversed.

In rejecting the claims, the Examiner states:

Claims 1, 3, 10, 12, 14, 21, 23, Powar discloses a method and apparatus for paying bills electronically using machine readable information from an invoice, for use at an ATM, comprising scanning a bill to form a bill image, wherein the bill image includes a barcode providing payment information, performing optical character recognition on the bill image to identify the payment information and processing the bill using the payment information (column 2 line 65 - column 3 line 5 and column 5 line 63 - column 6 line 35).

Claims 5, 16, 25, Powar teaches presenting payment options to the user and initiating a transfer of funds to pay the bill in response to a selected user input using a payment option selected by the user (column 5 lines 32-45).

Claims 6, 17, 26, Powar teaches displaying an amount of the bill to a user (column 6 lines 18-25).

Office Action dated September 7, 2006, page 4.

Claim 1 as amended herein is as follows:

1. A method in an automatic teller machine for processing a bill payment, the method comprising:
  - scanning a bill at the automatic teller machine to form a bill image, wherein the bill image includes a markup language providing payment information;
  - performing optical character recognition on the bill image to identify the payment information; and
  - processing a payment of the bill using the payment information.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single prior art reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of a claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Applicants respectfully submit that Powar does not identically show every element of the claimed invention arranged as they are in the claims; and, accordingly, does not anticipate the claims. With respect to claim 1, in particular, Powar does not teach or suggest “scanning the bill at the automatic teller machine to form a bill image, wherein the bill image includes a markup language providing payment

information”, and also does not teach or suggest “performing optical character recognition on the bill image to identify the payment information”.

The Examiner refers specifically to column 2 line 65 - column 3 line 5 and column 5 line 63 - column 6 line 35 of Powar as disclosing the invention. These sections are reproduced below for the convenience of the Examiner.

The machine readable information can be read from a biller's invoice in a number of ways, depending on how it is present on the invoice. For example, the biller could print the information using an optically-readable barcode, using a font designed for error-free optical character recognition, or using magnetically-readable characters (MICR). Alternatively, a magnetic strip could be provided on the invoice.

Powar, Col. 2, line 65 – Col.3, line 5.

When consumer C receives the bill and is ready to pay it, consumer C scans the bill electronically to capture the biller ID field and the C-B account number field (step S2). This information is transmitted from the scanning device to a computer (typically an appropriately programmed microprocessor) for processing. This could either be a personal computer controlled by consumer C or a processor built into the reader. For example, the consumer terminal might be an integrated telephone with a display screen, alphanumeric entry keys, an internal microprocessor and a barcode wand or reader.

The captured information is validated (S3), and if found invalid, the consumer is prompted (S4) to rescan the bill, the bill is rescanned (S5) and then rechecked (S3). The data is validated at several levels. The first level is to detect whether the expected number of bits or characters were read. At a second level, the error-correction and detection data included in the universal encoding region is used to detect and correct, if necessary, reading errors. At a third level, the data is compared to previously collected data from an earlier bill and the data is validated using tables of valid biller ID's and C-B account number ranges obtained from payment network 208.

Next (S6), consumer C enters a payment amount, a payment date and an identification of the source of the funds. of course, consumer C could rely on defaults, where the default payment amount is the scanned amount due, the payment date is the scanned due date and the source of funds is a preset bank account at a preset consumer bank. The preset information might be stored in the consumer's personal computer, screen telephone or smart card.

The information obtained in step S6 is used to generate an electronic bill pay order (S7), which is sent over payment network 208 in lieu of sending a paper check with the paper remittance stub to biller B. Once the bill pay order is electronically transmitted (S8) to payment network 208, payment network 208 handles all the other details of transferring the funds to biller B's account, sending A/R data 210 to biller B for credit to consumer C's account with biller B, etc.

Powar, Col. 5, line 53 – Col. 6, line 35.

Nowhere in the above recitations or anywhere else in Powar is it ever disclosed or suggested that a bill is scanned at an automatic teller machine to form a bill image that includes a markup language providing payment information. Powar never forms an image of a bill. In Powar, machine-readable information on the bill itself is scanned to capture information from the bill such as a biller ID field and a

C-B account number field. As indicated above, this scanned information is then transmitted from the scanning device to a computer for processing.

This procedure is quite different from the present invention as recited in claim 1 wherein a bill is scanned “at the automatic teller machine to form a bill image” that “includes a markup language providing payment information”, and then “performing optical character recognition on the bill image to identify the payment information”. Powar does not disclose or suggest forming an image of a bill at an automatic teller machine or elsewhere, and does not disclose or suggest performing automatic character recognition on a bill image. Powar, accordingly, does not disclose or suggest “scanning the bill at the automatic teller machine to form a bill image, wherein the bill image includes a markup language providing payment information” and “performing optical character recognition on the bill image to identify the payment information” as recited in claim 1, and does not anticipate claim 1. Claim 1, accordingly, patentably distinguishes over Powar in its present form.

Claims 3, 5 and 6 and newly added claim 30 depend from and further restrict claim 1 and are also not anticipated by Powar, at least by virtue of their dependency.

Independent claims 12 and 21 recite similar limitations as claim 1 and are not anticipated by Powar for similar reasons as discussed above with respect to claim 1. Claims 14, 16, 17, 23, 25, 26, 31 and 32 depend from and further restrict one of claims 12 and 21 and are not anticipated by Powar, at least by virtue of their dependency.

Therefore, the rejection of claims 1, 3, 5, 6, 10, 12, 14, 16, 17, 21, 23, 25, and 26 under 35 U.S.C. § 102 has been overcome.

Furthermore, Powar does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Powar actually teaches away from the presently claimed invention because it teaches scanning payment information directly from machine-readable information on a bill as opposed to scanning a bill at an automatic teller machine to form an image of the bill, and then performing optical character recognition on the bill image to identify payment information as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Powar and its teaching of scanning machine-readable information from a bill, one of ordinary skill in the art would not be led to modify Powar to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Powar in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants’ own disclosure as a template to make the necessary changes to reach the claimed invention.

**III. 35 U.S.C. § 103, Obviousness: Claims 4, 15 and 24**

The Examiner has rejected claims 4, 15 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Powar in view of Hidaka et al., U.S. Patent No. 6,782,402. This rejection is respectfully traversed.

The Examiner states:

Powar fails to teach adding a time stamp to the bill image.

Hidaka teaches a system and method for gathering image data by a scanner and storing said data in an image file, along with a timestamp (column 48 line 60 - column 49 line 10). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Powar to include a time stamping the image data for record keeping purposes as a record of when the bill was processed because such a record is vital and necessary for keeping records of invoices issued and bills paid.

Office Action dated September 7, 2006, pages 5-6.

Claims 4, 15 and 24 depend from and further restrict one of claims 1, 12 and 21. Hideka et al. does not supply the deficiencies in Powar as described above. Accordingly, claims 4, 15 and 24 are allowable over Powar in view of Hideka et al. at least by virtue of their dependency.

In addition, as discussed above, Powar does not disclose or suggest scanning a bill at an automatic teller machine to form an image of a bill. Therefore, it would not be obvious to one of ordinary skill in the art to modify Powar to add a time stamp to an image of a bill. Accordingly, claims 4, 15 and 24 patentably distinguish over Powar in view of Hideka et al. in their own right as well as by virtue of their dependency.

Therefore, the rejection of claims 4, 15 and 24 under 35 U.S.C. § 103(a) has been overcome.

**IV. 35 U.S.C. § 103, Obviousness: Claims 2, 13, and 22**

The Examiner has rejected claims 2, 13, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Powar, as applied above, in view of Nishijima et al., U.S. Patent No. 7,088,907 (hereinafter "Nishijima"). This rejection is respectfully traversed.

The Examiner states:

Powar fails to teach generating a video recording of the user during processing of the bill.

Nishijima teaches a video camera that is disposed near an automatic teller machine for capturing video of a user at the ATM, and attaching user information to the image capture. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Powar to include the video camera capturing device of Nishijima because the camera provides security, and security is very much desired at automatic teller machines.

Office Action dated September 7, 2006, page 6.

Claims 2, 13 and 22 depend from and further restrict one of claims 1, 12 and 21. Nishijima does not supply the deficiencies in Powar as described above. Accordingly, claims 2, 13 and 22 are allowable over Powar in view of Nishijima, at least by virtue of their dependency.

Therefore, the rejection of claims 2, 13, and 22 under 35 U.S.C. § 103(a) has been overcome.

**V. Conclusion**

For at least all the above reasons, claims 1-6, 12-17, 21-26 and 30-32 patentably distinguish over the cited art and are allowable thereover in their present form. This application, accordingly, is believed to be in condition for allowance and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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